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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/649,738	08/28/2000	Hulikunta Prahlad Raghunandan	JP920000198US1	7857

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International Business Machines Corporation
Almaden Research Center
650 Harry Road
San Jose, CA 95120

EXAMINER

TRAN, PHILIP B

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 03/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/649,738

Applicant(s)

RAGHUNANDAN, HULIKUNTA
PRAHLAD

Examiner

Philip B Tran

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Response to Amendments

1. This office action is in response to the amendments filed on 1/8/2004. Pending claims 1-9 are presented for further examination.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-9 are rejected under 35 U.S.C 103(a) as being unpatentable over Khanna et al (Hereafter, Khanna), U.S. Pat. No. 6,609,151 in view of Thurlow et al (Hereafter, Thurlow), U.S. Pat. No. 6,457,879.

Regarding claim 1, Khanna teaches in a computing system consisting of a processor, memory storage, input and output devices, a network interface adapter and a basic input/output system (BIOS) for booting, said system being connected to a remote computer [see Fig. 1], characterized in that said BIOS (108) includes a means to communicate with the network adapter (i.e., NIC 116) [see Fig. 1], and a means to access the said remote email server through network during the boot up process using said network adapter (i.e., electronic mail routine in the BIOS) [see Col. 6, Lines 1-10]. Khanna does not explicitly teach email server system and a means to download the email count for the current user from the remote email server on said network, and a means to display the email count for the current user in a defined format on the display of said computing system. However, the use of the client email application program interaction with the remote email server system for checking connection upon booting up and downloading email is well-known in the art as disclosed by Thurlow [see Abstract and Col. 7, Lines 4-61 and Col. 14, Lines 45-57]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to check email upon start-up because it would have enabled the user to configure email count received [see Col. 14, Lines 45-57].

Regarding claim 2, Khanna further teaches a system as claimed in claim 1 wherein the communication with said remote email server (remote computer) is through TCP/IP protocol [see Col. 1, Lines 30-42 and Col. 3, Lines 29-30].

Regarding claim 3, Khanna further teaches a system as claimed in claim 1 further comprising configuration means for configuring the designated users of the system during a previous system operation [see Col. 3, Lines 25-39 and Col. 5, Lines 39-50].

Claims 4-6 are rejected under the same rationale set forth above to claims 1-3.

Claims 7-9 are rejected under the same rationale set forth above to claims 1-3.

Response to Arguments

4. Applicant's arguments have been fully considered but they are not persuasive because of the following reasons :

Khanna teaches in a computing system consisting of a processor, memory storage, input and output devices, a network interface adapter and a basic input/output system (BIOS) for booting, said system being connected to a remote computer [see Fig. 1], characterized in that said BIOS (108) includes a means to communicate with the network adapter (i.e., NIC 116) [see Fig. 1], and a means to access the said remote email server through network during the boot up process using said network adapter (i.e., electronic mail routine in the BIOS) [see Col. 6, Lines 1-10]. Khanna does not explicitly teach email server system and a means to download the email count for the current user from the remote email server on said network, and a means to display the email count for the current user in a defined format on the display of said computing system. However, the use of the client email application program interaction with the remote email server system for checking connection upon booting up and downloading

email is well-known in the art as disclosed by Thurlow [see Abstract and Col. 7, Lines 4-61 and Col. 14, Lines 45-57]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to check email upon start-up because it would have enabled the user to configure email count received [see Col. 14, Lines 45-57].

*In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See **In re Keller**, 642F. 2d 413, 208 USPQ 871 (CCPA 1981); **In re Merck & Co.**, 800 F. 2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant obviously attacks references individually without taking into consideration based on the teaching of combinations of references as shown above. With respect to Khanna, applicant seems to argue points the examiner has already construed Khanna does not explicitly teach while restricting the arguments on the Khanna-Thurlow combined to arguments of no motivation.*

*In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. See **In re Nomiya**, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the*

art. See In re McLaughlin, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference. See In re Bozek, 163 USPQ 545 (CCPA) 1969. Every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. See In re Bode, 193 USPQ 12 (CCPA 1977). In this case, the reason for combining reference Khanna and Thurlow is that to check email upon start-up because it would have enabled the user to configure email count received [see Col. 14, Lines 45-57].

In response to applicant's arguments, the recitation accessing the email information by the BIOS during the BIOS boot up process has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See In re Hirao, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

*In response to appellant's arguments that the present invention involves checking and displaying an email count during the BIOS boot process. This enables displaying email count very quickly upon power up. This could mean not even having to wait for the BIOS boot process to finish. This feature on which the Applicant relies are not in the claims. It is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable. See **Constant v. Advanced Micro-Devices Inc.**, 7 USPQ2d 1064.*

Therefore, the examiner asserts that the cited prior arts properly teach or suggest the subject matter broadly recited in independent claims. Claims 2-3, 5-6 and 8-9 are rejected at least by virtue of their dependency on independent claims and by other reasons set forth above. Accordingly, rejections to claims 1-9 are respectfully maintained as shown above.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CAR 1.136(a).

A SHORTENED STATUTORY PERIOD FOR REPLY TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE MAILING DATE OF THIS ACTION. IN THE EVENT A FIRST REPLY IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CAR 1.136(A) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT, HOWEVER, WILL THE STATUTORY PERIOD FOR REPLY EXPIRE LATER THAN SIX MONTHS FROM THE MAILING DATE OF THIS FINAL ACTION.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tran whose telephone number is (703) 308-8767. The Group fax phone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam, can be reached on (703) 308-6662.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

PT
Philip Tran
Art Unit 2155
March 17, 2004


HOSAIN ALAM
SUPERVISORY PATENT EXAMINER